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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,799	02/08/2007	Philip Head	23615	5840
535 7590 01/05/2009 K.F. ROSS P.C. 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900			EXAMINER BUCK, MATTHEW R	
			ART UNIT 3671	PAPER NUMBER
			MAIL DATE 01/05/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/576,799	HEAD, PHILIP	
	Examiner	Art Unit	
	MATTHEW R. BUCK	3671	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

6DETAILED ACTION

Claim Objections

1. Claim 16 is objected to because of the following informalities: (line 9) spelling error: "performtion" should be change to "perforation". Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Head (5472052) and further in view of Bohn (3939927).
4. As concerns claims 1, 2, 5 and 16, Head shows a method of abandoning a well, said well comprising at least two concentric conduits defining a main bore and at least one annular chamber therebetween, the method comprising the steps of: lowering a tool into the well; forming a perforation in one or more of the conduits, withdrawing fluid from the annular chamber and/or main bore to create a fluid-free void, and inserting sealing material in the annular chamber and/or main bore to seal it/them (column 2, lines 11-42; column 7, lines 25-28). Head lacks to show lowering a pump into the well and withdrawing fluid by means of the pump. However, Bohn teaches the elements of claims 1, 2, 5 and 16 (22, 17; column 2, lines 26-29). One of ordinary skill in the art at the time the invention was made would have been motivated to modify the structure

taught in Head with the elements taught in Bohn because a pump is known to provide means for withdrawing well fluid from an area in which a perforation forming device is used.

5. As concerns claim 3, Head lacks to show wherein a tube is connected to the pump and the fluid is pumped to the surface through the tube. However, Bohn teaches the elements of claim 3 (11, 22; Fig. 2; column 2, lines 49-52). One of ordinary skill in the art at the time the invention was made would have been motivated to modify the structure taught in Head with the elements taught in Bohn because a tube is known to provide a direct and effective way to pump fluid to the surface.

6. As concerns claim 4, Head shows wherein the fluid is drawn downward into the well (column 5, lines 1-3). Head lacks to show wherein the fluid is drawn downward by the pump. However, Bohn teaches the elements of claim 4 (abstract). One of ordinary skill in the art at the time the invention was made would have been motivated to modify the structure taught in Head with the elements taught in Bohn for the reasons stated above.

7. As concerns claims 6 and 7, Head shows wherein perforations are formed in at least one conduit and the annular chamber is sealed at various levels between the conduits (column 2, lines 43-65; column 3, lines 19-29; column 4, lines 36-57).

8. As concerns claims 8, 11 and 14, Head shows an apparatus for abandoning a well having at least two concentric conduits, including a perforation forming device (column 3, lines 34-37; column 7, lines 25-28). Head lacks to show a pump down in the well and a cable, including a through bore, for lowering the pump in the well. However,

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Bohn teaches the elements of claim 8 (22, 17 and 11; column 2, lines 26-29). One of ordinary skill in the art at the time the invention was made would have been motivated to modify the structure taught in Head with the elements taught in Bohn for the reasons stated above.

9. As concerns claim 9, Head shows a check valve to permit one way flow of fluids (column 2, line 66 - column 3, line 4).

10. As concerns claim 10, Bohn shows wherein the pump and the valve unit are together. Note that it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Further, MPEP § 2144.04 states: In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961).

11. As concerns claim 12, Head lacks to show wherein the perforation forming device is incorporated into the pump. However, Bohn teaches the elements of claim 12 (31, 22). One of ordinary skill in the art at the time the invention was made would have been motivated to modify the structure taught in Head with the elements taught in Bohn because the combined structure is known to reduce the needed equipment to abandon a well.

12. As concerns claim 13, Head lacks to show wherein the perforation forming device is incorporated into the valve unit. However, Bohn teaches the elements of claim 13 (31, 28 and 29). One of ordinary skill in the art at the time the invention was made would have been motivated to modify the structure taught in Head with the elements taught in Bohn because the combined structure is known to reduce the needed

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equipment to abandon a well. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made since the expected result of this configuration improves efficiency of the abandoning well apparatus design.

Response to Arguments

13. Applicant's arguments filed 08/06/2008 have been fully considered but they are not persuasive. Applicants arguments regarding claim 1 are noted, but the elements are shown above in the rejection. Bohn is a teaching of the use of using pump as a tool, in which the primary reference Head has already shown the step of inserting a tool, thus as combined a pump, into the well.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW R. BUCK whose telephone number is (571) 270-3653. The examiner can normally be reached on Monday through Friday 7:30am - 5:00pm E.S.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on (571) 272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas A Beach/
Primary Examiner, Art Unit 3671

mrb